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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,277	07/09/2001	Osamu Nagata	7217/64520	7556

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EXAMINER

PSITOS, ARISTOTELIS M

ART UNIT	PAPER NUMBER
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2653

DATE MAILED: 02/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/901,277

Applicant(s)

NAGATA ET AL.

Examiner

Aristotelis M Psitos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Applicant response of 10/4/04 has been considered with the following results.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(f) he did not himself invent the subject matter sought to be patented.

2. Claim 1 is rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter.

The following analysis is made:

Claim 1

6631100

A recording medium having an

see abstract:

area in which a plurality of programs are managed into a

area inherently present

plurality of groups and recorded in this form, comprising:

toc area for instance,

a medium name recording area having a recording medium name

see abstract, with respect to

recorded thereon for identifying the recording medium,

medium name see disc name

designation in u-toc area in fig. 5

a program recording area having the plurality of programs recorded thereon;

remaining area of disc

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a first management data area having first management data recorded thereon for managing the plurality of programs;

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link information

and

a second management data area having second management data recorded thereon for managing program names corresponding to each of the plurality of programs and groups names corresponding to each plurality of groups,

program names present

group name inherently present, i.e., album title

separating information for separating the program names and the group names,

see col. 12 lines 9-57

and group partitioning information for partitioning each grouping formed of program numbers, the group name, and separating information

so that a beginning program number and an ending program number is properly identified for each grouping.

In the above interpretation of the claimed elements, the examiner concludes that the partitioning character although specified for separating "title", the ability to also provide such a separation for partitioning the numbers, names, etc. so as to properly identify each grouping is inherently present – see the additional discussion with starting and ending track # as shown in figure 4 and discussed therewith wherein the "partitions" are so depicted.

3. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Kurakake et al.

The following analysis is made:

Claim 1

5808223

A recording medium having an

see abstract: also

area in which a plurality of programs are managed into a plurality of groups and recorded in this form, comprising:

col. 4, lines 58-63, record present
see col. 1 lines 35-40 for instance,

a medium name recording area having a recording medium name recorded thereon for identifying the recording medium,

see col 1 lines 35-40, name
of singer, or author in trunk
chunk TC (col. 6 lines 55-57)

a program recording area having the plurality of programs

remaining area of disc

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recorded thereon;

a first management data area having first management data recorded thereon for managing the plurality of programs; and

searching ability
col. 1 lines 35-40

a second management data area having second management data recorded thereon for managing program names corresponding to each of the plurality of programs and groups names corresponding to each plurality of groups,

program names present,
see col. 11 lines 50+

separating information for separating the program names and the group names,

see fig. 7a, col. 8, lines 28,

and group partitioning information for partitioning each grouping formed of program numbers, the group name, and separating information

so that a beginning program number and an ending program number is properly identified for each grouping.

see description of fig. 8.

In the above analysis, the examiner interprets the "/" as the partitioning information which permits the system to group designated data fields together, in fig. 7a, this is the program time data and the additional text event data. Nevertheless, such partitioning permits a beginning program number, the TL1 in fig. 7a and the ending program number, TL4 in fig. 7a to be properly identified for each group.

4. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Matsumoto et al.

The following analysis is made:

Claim 1

6462263

A recording medium having an

see abstract: also
Col. 1 lines 5-12.

area in which a plurality of programs are managed into a plurality of groups and recorded in this form, comprising:

pl. programs are
each of the music names

a medium name recording area having a recording medium name recorded thereon for identifying the recording medium,

col 2 line 45 to col. 3 line 10
names of music,singer,program

a program recording area having the plurality of programs recorded thereon;

remaining area of disc

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a first management data area having first management data recorded thereon for managing the plurality of programs; and

searching ability by
col. 1 lines 15-39

a second management data area having second management data recorded thereon for managing program names corresponding to each of the plurality of programs and groups names corresponding to each plurality of groups,

see description of fig. 1

separating information for separating the program names and the group names,

col. 3 lines 5-9

and group partitioning information for partitioning each grouping formed of program numbers, the group name, and separating information

so that a beginning program number and an ending program number is properly identified for each grouping.

In the above analysis, the record medium described has appropriate attribute information, name of disc, artist, music, tracks, etc. described with respect to figure 1, col. 1 line 48 to col. 2 line 2.

The reference also discloses the use of delimiters – col. 3 lines 5-9 which perform the ability to partition each of the groups appropriately so that beginning and ending program numbers, track numbers are properly identified.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dockes et al further considered with Matsumoto et al.

Dockes et al discloses a record medium having the appropriate areas: management area and program area – see the description of the tables commencing at col 12, with table 1, wherein the examiner interprets the tables 3,8 and 12 for instance as the program information, and that of tables 4-7,9-11, as the management information.

The medium name area is that corresponding to the information designated in table 2.

There is no clear depiction of any ability to partition the information appropriately.

Matsumoto et al teaches in this environment the use of delimiters – see col. 3, lines 5-9 for separating the data fields.

It would have been obvious to modify the base system of Dockes et al with the above teaching from Matsumoto et al, motivation is to permit separation of the data fields in order to be more recognizable and hence decreasing confusion and the processing time.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the

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conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4/1 & 3/1 of U.S. Patent No. 6,580,679 in view of Matsumoto et al. The following analysis is made:

Claim 1	6580679
A recording medium having an	claim 1 line 1
area in which a plurality of programs are managed into a plurality of groups and recorded in this form, comprising:	inherently present
a medium name recording area having a recording medium name recorded thereon for identifying the recording medium,	claim 2 entirely
a program recording area having the plurality of programs recorded thereon;	claim 1 line 3
a first management data area having first management data recorded thereon for managing the plurality of programs;	claim 1 lines 4-8
and	
a second management data area having second management data recorded thereon for managing program names corresponding to each of the plurality of programs and groups names corresponding to each plurality of groups,	claim 1, lines 9-11 claim 4 entirely
separating information for separating the program names and the group names,	
and group partitioning information for partitioning each grouping formed of program numbers, the group name, and separating information	
so that a beginning program number and an ending program number is properly identified for each grouping.	

The above claims conflict and are obvious because although the partitioning ability provided by the "claimed separating information is not found in the above patent, such is taught by the Matsumoto et al reference, see the discussion with respect to the delimiters at col. 3 lines 5-9.

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It would have been obvious to modify the base system of the above noted patent (claims 4/1 & 3/1) with the above teaching from Matsumoto, motivation is to permit easily recognizable data fields, and hence reduce confusion and processing time.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. EP 655740 also describes fat files, which are interpreted as the second management data of the above claim.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M Psitos whose telephone number is (703) 308-1598. The examiner can normally be reached on M-Thursday 8 - 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (703) 305-6137. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aristotelis M Psitos
Primary Examiner
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A handwritten signature in black ink, appearing to be 'A. Psitos', written over a circular stamp or seal.

AMP